

REMARKS

Applicant has carefully reviewed the Examiner's February 11, 2004 Official Action and respectfully requests reconsideration based on the above amendments and the following comments.

Claims 1-10 remain in the application for consideration.

The Examiner has rejected claims 1-10 under 35 U.S.C. 103(a) as being unpatentable over the newly patent to Ichinose '618 in view of Mark '178 and further in view of the newly cited patent to Hamada '160. Applicant respectfully traverses this rejection for the following reasons.

The Examiner indicates that Mark discloses a vehicle door striker similar to that of Ichinose. Applicant does not agree. The only similarity between the structures of Ichinose and Mark is the fact they are intended to be strikers. Mark is different from the Ichinose striker at least in the following respects:

- (1) The first and second leg parts of Mark do not have the same shape;
- (2) The first and second leg parts of Mark are not parallel to each other;

- (3) The first and second leg parts of Mark are not perpendicular to the plane of its metal base;
- (4) The Mark latch engages bolt engaging portion 22 and not either limb 18 or 20; and
- (5) Limbs 18 and 20 of Mark are bent to different respective angles so that the longitudinal axis of bolt engaging portion 22 is twisted with respect to the longitudinal median axis of base 12.

In the last full paragraph of page 3, Mark indicates that its structural features are intended to permit strikers to be made in complex shapes different from conventional strikers so as to suit specific applications, particularly where the limbs need to be bent as shown in the Mark drawings.

Accordingly, Applicant does not agree that the combination of Ichinose and Mark would be obvious to the skilled artisan, especially in light of the indication in the last full paragraph of page 3 of Mark that the different features of Mark are intended for use in strikers other than conventional strikers such as Ichinose. (Mark indicates in the last full paragraph on page 3 that a striker is conventional if

it has "limbs of uniform diameter throughout their length" which is clearly the case with Ichinose.)

This paragraph further continues by indicating that in such a conventional striker, i.e. Ichinose, "the overall diameter of the loop would be dictated by the sizing needed to match the claw or other latching bolt". This statement clearly teaches away from modifying the uniform diameter of the limbs of Ichinose as suggested by the Examiner and teaches only the partial thickening of bent legs.

Even assuming the obviousness of the Examiner's suggested prior art combination (not admitted), there is no teaching whatever in any of the cited prior art that if the first leg of Ichinose was modified to have a large diameter, that the latch of Ichinose would necessarily engage its first leg above the large diameter portion as claimed by Applicant rather than the large diameter portion. Indeed, Mark teaches engagement of the latch to engaging portions 22 rather than a specific part of the first leg as claimed by Applicant so that there is no teaching whatever of whether the Ichinose latch would engage its modified legs.

With regard to claim 2, Applicant further notes that legs of Mark each have a different shape. Accordingly, there

is no teaching in the cited prior art of making the modified Ichinose legs the same shape.

With regard to claim 4, the tapered parts on the Mark legs are different from one another. Accordingly, there is no teaching of the cited prior art of making the tapered parts of the modified Ichinose the same as claimed.

With regard to claims 5, 6, 8 and 10, again Mark teaches different lengths for the reinforced large diameter part on its first and second legs wherein there is no teaching in the cited prior art of making each leg of the modified Ichinose striker the same length.

The law is clear that in order to establish a proper *prima facie* case of obviousness based on a combination of references, the prior art must contain some reason, purpose, motivation, incentive or teaching of the proposed combination. One of the leading cases in this regard is Ex parte Clapp, 227 USPQ 972, where the Honorable Board stated:

Presuming *arguendo* that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant

application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination.

The same is true in the present case. Applicant here also has presented claims to a new combination of elements.

To support the conclusion that the claimed combination is directed to obvious subject matter either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. ... Based on the record before us, we are convinced that the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness. Note In re Horn, 203 USPQ 969, 971 (CCPA 1979). Accordingly, we will not sustain any of the rejections presented.

As seen from the above analysis of Ichinose and Mark, there is not the remotest inference in either reference, or any other prior art known to Applicant, leading the skilled worker in this art toward the proposed combination, especially in light of the major difference in structural elements between Ichinose and Mark. The combination is obvious only in retrospect, i.e. after having looked at Applicant's specification, but it was not (would not have been) obvious to a person of normal skill

in the art at the time the present invention was made. The prior art does not provide the incentive, motive, reason, purpose, teaching or basis for the combination, and therefore the combination would not have been obvious. In the last full paragraph on page 3 of Mark, Mark teaches away from the suggested combination. Further, the cited prior art provides no teaching whatever as to where the Ichinose latch would engage the modified leg suggested by the Examiner as identified in the claims.

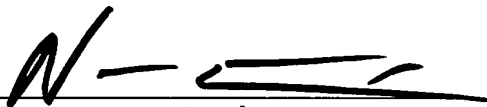
Further, as noted above, even if the combination were obvious, it does not produce the claimed subject matter.

Applicant submits that the invention is new and unobvious and not disclosed by the cited art. Accordingly, Applicant respectfully solicits the Examiner's early review and issuance of this application.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

By


Norman J. Latker
Registration No. 19,963

NJL:ma
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
C:\Windows\Desktop\Amend-Sawajiri2.doc